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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/813,408	03/21/2001	Simon Delagrave	HER-0041	2931

7590 12/13/2002

Christine A. Goddard, Ph.D.
WOODCOCK WASHBURN KURTZ
MACKIEWICZ & NORRIS LLP
One Liberty Place - 46th Floor
Philadelphia, PA 19103

EXAMINER
TRAN, MY CHAU T

ART UNIT	PAPER NUMBER
1639	

DATE MAILED: 12/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/813,408	DELAGRAVE ET AL.	
	Examiner	Art Unit	
	My-Chau T. Tran	1639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondenc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-56 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) 1-56 are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-9, drawn to a method of preparing a polynucleotide having a target sequence from a plurality of oligonucleotides with coupling the oligonucleotides, classified in class 435, subclass 6.

II. Claim 10, drawn to a library of polynucleotides, classified in class 436, subclass 86.

III. Claims 11-22, drawn to a method of preparing a polynucleotide having a target sequence from a plurality of oligonucleotides with blocking the 3' end of each oligonucleotides, classified in class 435, subclass 4.

IV. Claims 23-25, drawn to a method of coupling a first oligonucleotide with a further oligonucleotide, classified in class 536, subclass 25.3.

V. Claims 26-39, drawn to a method of preparing a library of polynucleotides having a target sequence from a plurality of oligonucleotides with coupling the oligonucleotides, classified in class 436, subclass 94.

VI. Claims 40-52, drawn to a method of preparing a library of polynucleotides having a target sequence from a plurality of oligonucleotides with blocking the 3' end of each oligonucleotides, classified in class 436, subclass 90.

VII. Claims 53 and 55, drawn to a method of identifying a polynucleotide with a predetermined property with generating a library of polynucleotides according to the method of claim 26, classified in class 435, subclass 3.

VIII. Claims 54 and 56, drawn to a method of identifying a polynucleotide with a predetermined property with generating a library of polynucleotides according to the method of claim 40, classified in class 436, subclass 55.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Groups I, III, IV, V, VI, VII and VIII are unrelated and independent inventions. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions as claimed have different method steps that have different effects and modes of operation.

The method step of coupling the oligonucleotides to form a plurality of coupled oligonucleotides of Group I is not required by the claims of Group III, IV, V, VI, VII, and VIII. The method step of blocking the 3' end of the oligonucleotides with a blocking group to form a plurality of blocked oligonucleotides of Group III is not required by the claims of Group I, IV, V, VI, VII, and VIII. The method step attaching the first oligonucleotide to a solid support of Group IV is not required by the claims of Group I, III, V, VI, VII, and VIII. The method step of coupling the oligonucleotides to form a plurality of coupled oligonucleotides and the method step wherein the polynucleotides shares a plurality of predetermined sequence positions of Group V is not required by the claims of Group I, III, IV, VI, VII, and VIII. The method step of

blocking the 3' end of the oligonucleotides with a blocking group to form a plurality of blocked oligonucleotides and the method step wherein the polynucleotides shares a plurality of predetermined sequence positions of Group VI is not required by the claims of Group I, III, IV, V, VII, and VIII. The method step of generating a library of polynucleotides according to the method of claim 26 and the method step of selecting one polynucleotide within the library having a predetermined property of Group VII is not required by the claims of Group I, III, IV, V, VI, and VIII. The method step of generating a library of polynucleotides according to the method of claim 40 and the method step of selecting one polynucleotide within the library having a predetermined property of Group VIII is not required by the claims of Group I, III, IV, V, VI, and VII.

3. Inventions of Group II (product) and Group I (process) are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by a materially different process such as of Group IV or VI.

4. Inventions of Group II (product) and Group III (process) are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP §

806.05(f)). In the instant case the product as claimed can be made by a materially different process such as of Group IV or V.

5. Inventions of Group II (product) and Group IV (process) are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by a materially different process such as of Group III or VI.

6. Inventions of Group II (product) and Group V (process) are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by a materially different process such as of Group IV or I.

7. Inventions of Group II (product) and Group VI (process) are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP §

806.05(f)). In the instant case the product as claimed can be made by a materially different process such as of Group III or I.

8. Inventions Group II (product) and Group VII (process) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process such as the method of protein synthesis.

9. Inventions Group II (product) and Group VIII (process) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process such as the method of protein synthesis.

10. Because these inventions are distinct for the reasons given above and the searches required are not co-extensive thus requiring a burdensome search, restriction for examination purposes as indicated is proper. Additionally, different patentability considerations are involved for each group. For example, a patentability determination for Group III would involve a determination of the patentability of the method step of blocking the 3' end of the

oligonucleotides with a blocking group to form a plurality of blocked oligonucleotides while a patentability determination for Group V would involve a consideration of the patentability of the combination of the method step of coupling the oligonucleotides to form a plurality of coupled oligonucleotides and the method step wherein the polynucleotides shares a plurality of predetermined sequence positions (independent of its use). These considerations are very different in nature.

1. This application contains claims directed to the following patentably distinct species of the claimed invention.

2. If applicants elect the invention of **Group III (Claims 11-22)**, applicants are required to further elect ***a single specific species of solid support of Claim 15***.

3. If applicants elect the invention of **Group VI (Claims 40-52)**, applicants are required to further elect ***a single specific species*** from ***each species groups***. The species groups are as follow: **Group A** refer to the type of solid support of ***Claim 44*** and **Group B** refer to the type of common property of ***Claim 49, 50, and 51.***

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. ***Currently, claims 1-14, 16-43, 45-48, and 52-56 are generic.***

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to My-Chau T. Tran whose telephone number is 703-305-6999. The examiner is on ***Increased Flex Schedule*** and can normally be reached on Monday: 8:00-2:30; Tuesday-Thursday: 7:30-5:00; Friday: 8:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang can be reached on 703-306-3217. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1123.

mct
December 10, 2002

PADMASHRI PONNALURI
PRIMARY EXAMINER